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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,792	10/01/2001	Pascale Bernard	05725.0963-00	3391

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EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,792

Applicant(s)

BERNARD ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 23-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-22 and 43-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### DETAILED ACTION

In the decision issued May 31, 2005, BPAI has reversed the final rejections, but directed attention to Leuridan et al. Following rejections are made by following the Board's directions.

#### *Double Patenting Rejections*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-12, 15-22, 43-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,372,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims herein and that of '201 substantially overlaps.

1. particularly, Leuridan et al. claims a nail vanishing composition having first and second solvent, and a polymer with  $T_g - MFT \leq 20^\circ\text{C}$ , which overlaps the polymer herein claimed in the range of  $8^\circ\text{C} \leq T_g - MFT \leq 20^\circ\text{C}$ . The solvents employed in Leuridan et al. also meet the limitation for solvent herein. Particularly, it is noted that the first organic solvent of this invention is stated to be a coalescing agent. Specification, page 21. The second organic solvent of Leuridan is also stated to be a coalescing agent. Column 3, lines 42 - 44. It is also noted that

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Leuridan lists as the second organic solvent/coalescing agent compounds such as propylene glycol n-butyl ether, propylene glycol methyl ether acetate, and isopropyl lactate which are set forth on page 22 of the specification as being examples of the first organic solvent of this invention.

2. Furthermore, it is noted that the second organic solvent of this invention is stated to be a plasticizer. Specification, page 22. The first organic solvent of Leuridan is also stated to be a plasticizer. Column 3, lines 9-11. Leuridan describes diethyl adipate, diethyl phthalate, dibutyl phthalate, and diisobutyl adipate as examples of the first organic solvent/plasticizer of that invention. These compounds are set forth on page 23 of the specification as being examples of the second organic solvent of this invention.

2.

### ***Claim Rejections 35 U.S.C. 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12, 15-22, 43-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Leuridan et al. (US 6,372,201).

5. Leuridan describes a nail varnish composition that comprises an aqueous polymer dispersion, a first organic solvent, and a second organic solvent. See, e.g., column 1, lines 35 -

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40, column 3, lines 9 - 65. The polymer may have the relationship  $T_g - MFT \leq 20^\circ\text{C}$ . Column 1, line 40.

6. It is noted that the first organic solvent of this invention is stated to be a coalescing agent. Specification, page 21. The second organic solvent of Leuridan is also stated to be a coalescing agent. Column 3, lines 42 - 44. It is also noted that Leuridan lists as the second organic solvent/coalescing agent compounds such as propylene glycol n-butyl ether, propylene glycol methyl ether acetate, and isopropyl lactate which are set forth on page 22 of the specification as being examples of the first organic solvent of this invention.

7. Furthermore, it is noted that the second organic solvent of this invention is stated to be a plasticizer. Specification, page 22. The first organic solvent of Leuridan is also stated to be a plasticizer. Column 3, lines 9-11. Leuridan describes diethyl adipate, diethyl phthalate, dibutyl phthalate, and diisobutyl adipate as examples of the first organic solvent/plasticizer of that invention. These compounds are set forth on page 23 of the specification as being examples of the second organic solvent of this invention.

8. Finally, Example 1 of Leuridan that describes a nail varnish which comprises an aqueous polymer dispersion (JONCRYL SCX-8211, an acrylate-styrene copolymer), diisobutyl adipate which is one of the exemplified second organic solvents of the present invention and propylene glycol n-butyl ether and dipropylene glycol n-butyl ether which are exemplified in the present specification as being the first organic solvent.

9. It is noted that Leuridan et al. do not disclosed expressly that the polymers employed in example 1 meets the relationship  $T_g - MFT \geq 8^\circ\text{C}$  required by the claims in this application.

However, since the polymers employed in the example 1 meet the structural limitation herein, it

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would have reasonably expected that the polymer in example 1 have the same physical properties as herein defined. It is applicant's burden to establish by objective evidence whether the specific polymer used in Example 1 of Leuridan meets this aspect of the present claims under the principles set forth in *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

***Claim Rejections 35 U.S.C. 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-12, 15-22, 43-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leuridan et al. (US 6,372,201).

12. Leuridan describes a nail varnish composition that comprises an aqueous polymer dispersion, a first organic solvent, and a second organic solvent. See, e.g., column 1, lines 35 - 40, column 3, lines 9 - 65. The polymer may have the relationship  $T_g - MFT \leq 20^\circ\text{C}$ . Column 1, line 40. Preferred polymers are acrylate-styrene copolymers. See, particularly, col. 2, lines 7-25 and 64-67. The composition exhibits good properties such as adhesion to the nail and brightness and also removability with conventional removers. Col. 1, lines 24-28.

13. It is noted that the first organic solvent of this invention is stated to be a coalescing agent. Specification, page 21. The second organic solvent of Leuridan is also stated to be a coalescing agent. Column 3, lines 42 - 44. It is also noted that Leuridan lists as the second organic solvent/coalescing agent compounds such as propylene glycol n-butyl ether, propylene glycol

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methyl ether acetate, and isopropyl lactate which are set forth on page 22 of the specification as being examples of the first organic solvent of this invention.

14. Furthermore, it is noted that the second organic solvent of this invention is stated to be a plasticizer. Specification, page 22. The first organic solvent of Leuridan is also stated to be a plasticizer. Column 3, lines 9-11. Leuridan describes diethyl adipate, diethyl phthalate, dibutyl phthalate, and diisobutyl adipate as examples of the first organic solvent/plasticizer of that invention. These compounds are set forth on page 23 of the specification as being examples of the second organic solvent of this invention.

15. Finally, Example 1 of Leuridan that describes a nail varnish which comprises an aqueous polymer dispersion (JONCRYL SCX-8211, an acrylate-styrene copolymer), diisobutyl adipate which is one of the exemplified second organic solvents of the present invention and propylene glycol n-butyl ether and dipropylene glycol n-butyl ether which are exemplified in the present specification as being the first organic solvent.

16. It is noted that Leuridan et al. do not disclosed expressly that the polymers employed therein meet the relationship  $T_g - MFT \geq 8^\circ\text{C}$  required by the claims in this application.

However, since the polymers employed in the example 1 meet the structural limitation herein, it would have reasonably expected that the polymer in example 1 have the same physical properties as herein defined. It is applicant's burden to establish by objective evidence whether the specific polymer used in Example 1 of Leuridan meets this aspect of the present claims under the principles set forth in *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Further, since the scope of polymers required by Leuridan et al. ( $T_g - MFT \leq 20^\circ\text{C}$ ) overlaps the scope of polymers herein ( $T_g - MFT \geq 8^\circ\text{C}$ ) in a range of  $8^\circ\text{C} \leq T_g - MFT \leq 20^\circ\text{C}$ , it would

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have been obvious to one of ordinary skill in the art to employ a polymer with a property of  $8^{\circ}\text{C} \leq T_g - MFT \leq 20^{\circ}\text{C}$  in Leuridan's nail vanishing composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG  
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